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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,125	10/25/2000	James M. Welch	7000-032	3540

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EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 05/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/696,125

Applicant(s)

WELCH ET AL.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 26-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56 is/are allowed.
- 6) ☒ Claim(s) 1, 13-17, 26, 36-38, 41-45, 47, 49-50, 52-55, 57-58 is/are rejected.
- 7) ☒ Claim(s) 2-12, 27-35, 39, 40, 46, 48, 51, 59, 60 and 63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 61 and 62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A/. Regarding claim 61, the specification fails to clearly describe how the callers associated with a single line subscription to generate a plurality of customized CIDs through a packet based network, emphasis added.

B/. Regarding claim 62, the specification described on page 9 the local exchange switch 12 screens each of dialable numbers stored in the screen list against the dialed number. If one of the stored dialable numbers matched to the dialed number, the corresponding customized CID is retrieved from such list. The specification fails to clearly describe the feature of screening each of plurality of customized CIDs for appropriate material. The Applicants are required to point out wherein the specification supports such features.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 13-17, 26, 36-38, 41-45 and 57-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhodes (U.S. Pat. #: 6,343,120 as cited in the previous Office Action).

Regarding claim 1, Rhodes teaches a method of providing custom calling party identification information, the method comprising:

determining that customized CID information is desired by a call originator (i.e., determining a public name field "00" or alias information field, "01", "02", etc.) for a call originating from an origination end-point, wherein the customized CID information corresponds to a unique name selected by the call originator from a plurality of unique names (i.e., "J. Johnson" or "Sonny"); and

providing the customized CID information in association with the call;

wherein a device receiving the call can receive the customized CID information (col.4, line 44 –col.5, line 30).

Regarding claims 13-15 and 17, note indicators "01" and "00" in col.4, lines 27-43.

Regarding claim 16, note col.5, lines 19-30.

Regarding claim 26, the limitations of the claim are rejected with the same reasons set forth in claim 1 above.

Regarding claims 36-37, note indicators "01" and "00" in col.4, lines 27-43.

Regarding claim 38, Moss teaches an apparatus facilitating provision of custom calling party identification (CID) comprising:

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a means for selectively interconnecting a plurality of origination end-points in support of telecommunications functions based on dialable number information entered via individual ones of the plurality of origination end-points (col.3, line 52 – col.4, line 25);

means for determining that customized CID information is desired by a call originator (i.e., determining a public name field “00” or alias information field, “01”, “02”, etc.) for a call originating from an origination end-point, wherein the customized CID information corresponds to a unique name selected by the call originator from a plurality of unique names (i.e., “J. Johnson” or “Sonny”); and

means for determining at least one custom value for use as at least a part of the customized CID information;

means for transmitting the customer ID information in associated with the call (col.4, line 44 – col.5, line 30).

Regarding claims 41-45, note indicators “01” and “00” in col.4, lines 27-43.

Regarding claim 57, Rhodes teaches a method of providing customized calling party identification (CID) information to called party, the method comprising:

allowing callers associated with a single line subscription to generate a plurality of customer CIDs associated with the single line subscription (i.e., allowing callers such as extensions of PBX system with a signal line subscription such as telephone 200 as shown figure 2 connected to the PBX 201);

allowing the callers to designate a designated CID from the plurality of customized CIDs, the designated CID selected to be used when a call is made from a telecommunication line associated with the single line subscription; and

passing the designated CID to a call recipient (col.4, line 44 – col.5, line 30).

Regarding claim 58, note col.4, lines 28-43.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 47, 49-50 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strauss et al. (U.S Pat. #: 5,864,612 also cited in the previous Office Action) in view of Rhodes (U.S. Pat. #: 6,343,120).

Regarding claim 47, Strauss et al. ("Strauss") teaches a telecommunications local exchange switch such as SSP type central office shown in figure 2 comprising a first interface, a second interface (i.e., Interface Modules 51), a switching system (i.e., Communication Module

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53) and a controller (i.e., Administrative Module 55). Strauss further teaches the controller adapted to selectively provide customized CID information in association with calls originating from at least one of the plurality of origination end-points based on the program instructions and operating data (i.e., if a call is dialed without access code, the call is processed and routed in conventional manner; col.7, line 60 – col.8, line 3; otherwise, the SSP queries and follows instructions to transmit custom CID to destination for completing the call; col.8, lines 35-50 and col.9, lines 3-20).

It should be noticed that Strauss fails to clearly teach the feature of the customized CID information corresponds to a unique name selected by the call originator from a plurality of unique names. However, Rhodes teaches such feature in col.5, lines 17-30 for a purpose of providing the caller to selectively transmit caller ID to the called party and display at the called party's telephone terminal.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of said feature of the customized CID information corresponds to a unique name selected by the call originator from a plurality of unique names, as taught by Rhodes, into view of Strauss in order to provide the called party with the caller id information, even though the amount of information associated with the calling party is limited.

Regarding claims 49-50 and 52-55, Moss further teaches limitations of the claim in col.4, line 12-67.

***Allowable Subject Matter***

7. Claim 56 is allowed.

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8. Claims 2-12, 27-35, 39-40, 46, 48, 51, 59-60 and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-56 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

**Any response to this final action should be mailed to:**

**Box AF**

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

**Or faxed to:**

**(703) 872-9314 (for formal communications; please mark**

**"EXPEDITED PROCEDURE")**

**Or:**

**If it is an informal or draft communication, please label  
"PROPOSED" or "DRAFT")**

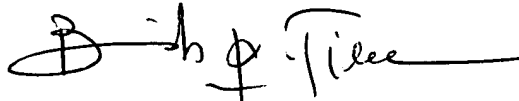


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**Customer Service (703) 306-0377**  
**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. Sixth Floor (Receptionist).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

A handwritten signature in black ink, appearing to read 'Binh Tieu', with a stylized flourish at the end.

**BINH TIEU**  
**PRIMARY EXAMINER**

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Date: May 24, 2004